



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,793	03/01/2002	Paul Turgeon	044624-15-CIP	1539

20350 7590 12/27/2005

TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER

BADII, BEHRANG

ART UNIT PAPER NUMBER

3621

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/086,793

Applicant(s)

TURGEON, PAUL

Examiner

Behrang Badii

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15, 40-54, 61-69 and 77-90 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 40-54, 61-69 and 77-90 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### ***Response to Arguments***

Applicant's arguments filed on 10/6/05 have been fully considered but they are not persuasive. IBM clearly discloses the use of a pair of PINs as discussed below.

#### **2112 [R-3] Requirements of Rejection Based on Inherency; Burden of Proof**

The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. "The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness." *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) (affirmed a 35 U.S.C. 103 rejection based in part on inherent disclosure in one of the references). See also *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983).

*In re Shepard*, 138 USPQ 148 (CCPA 1963)

In considering disclosure of reference patent, it is pertinent to point out not only specific teachings of patent but also the **reasonable inferences** which one skilled in the art would logically draw therefrom.

### **DETAILED ACTION**

Applicant elects to prosecute the claims of group IV, claims 1-15, 40-54, 61-69 and 77-90 without traverse. Claims 16-39, 55-60 and 70-79 are cancelled. The restriction requirement is still deemed proper and is therefore made FINAL. Claims 1-15, 40-54, 61-69 and 77-90 have been examined.

P = paragraph, e.g. p1 = paragraph 1.

***Claim Rejections - 35 USC § 103***

Art Unit: 3621

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15, 40-54, 61-69 and 77-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin, Jr. et al., U.S. patent application publication 2004/0199467, and further in view of Levine et al., U.S patent RE38,255 and IBM, Research Disclosure RD414097.

As per claims 1, 40 and 77 Martin, Jr. et al., discloses a method/system of providing a payment service including the steps of:

processing a payment service request having independent identification information and ATM network compatible PINS, including the steps of (abstract, p4) validating said independent identification information (p4); and generating an ATM network transaction message containing at least a selected one of said pair of ATM network compatible PINS based at least in part on said validating step (p2&5); and forwarding said ATM network transaction message to a financial institution over an ATM network for payment (p5).

Martin, Jr. et al. do not disclose a pair of ATM network compatible PINS. The IBM research disclosure and Levine et al. disclose a pair of ATM network compatible PINS (IBM RD; Levine et al.: col.7, 1-9). It would have been obvious to modify Martin, Jr. et al. to include a pair of ATM network compatible PINS such as that taught by IBM

RD and Levine et al. in order to have a first and a second pin to a user of an ATM card, each pin providing access to different parts of the transaction.

As per claim 61 Martin, Jr. et al. discloses a method of a providing payment service comprising the steps of (abstract):  
providing independent identification information associated with said user's account at said financial institution (p4);  
validating said independent identification information (p4);  
generating a payment service request including an ATM PIN based upon said validating step (p2 & 5); and  
forwarding said payment service request to said user's financial institution over an ATM network for further processing (p5). Martin, Jr. et al. does not disclose providing an encoded data storage device to a user; said encoded data storage device including:  
data representing a first ATM network compatible PIN; wherein said first ATM PIN is a valid ATM PIN associated with said user's account at a financial institution;  
data representing a second ATM network compatible PIN; wherein said second ATM PIN is an invalid ATM PIN not associated with said user's account at said financial institution;  
first ATM PIN or said second ATM PIN.

Levine et al. and IBM RD disclose providing an encoded data storage device to a user (Levine et al.: col.7, 1-9); said encoded data storage device including:

data representing a first ATM network compatible PIN; wherein said first ATM PIN is a valid ATM PIN associated with said user's account at a financial institution (Levine et al.: col.7, 1-9);

data representing a second ATM network compatible PIN (IBM RD); wherein said second ATM PIN is an invalid ATM PIN not associated with said user's account at said financial institution (Levine et al.: col.6, 11-24; col.7, 1-9 and 39-55);  
first ATM PIN or said second ATM PIN (IBM RD).

It would have been obvious to modify Martin, Jr. et al. to include an encoded data storage device to a user; said encoded data storage device including:

data representing a first ATM network compatible PIN; wherein said first ATM PIN is a valid ATM PIN associated with said user's account at a financial institution;

data representing a second ATM network compatible PIN; wherein said second ATM PIN is an invalid ATM PIN not associated with said user's account at said financial institution; and

first ATM PIN or said second ATM PIN such as that taught by Levine et al. and IBM RD in order to have a first and a second pin to a user of an ATM card, each pin providing access to different parts of the transaction.

As per claim 2, 41 & 78 Martin, Jr. et al. discloses a payment service as described above. Martin et al. does not disclose providing a data storage device for interacting with a network access device; said data storage device having said pair of ATM network compatible PINS stored thereon; wherein each one of said pair of ATM

Art Unit: 3621

network compatible PINs being independently encrypted and different from one another. Levine et al. discloses providing a data storage device for interacting with a network access device; said data storage device having said pair of ATM network compatible PINS stored thereon (col.7, 1-9). IBM RD does disclose a pair of ATM network compatible PINs being independently encrypted and different from one another. It would have been obvious to modify Martin, Jr. et al. to include a data storage device for interacting with a network access device; said data storage device having said pair of ATM network compatible PINS stored thereon; wherein each one of said pair of ATM network compatible PINs being independently encrypted and different from one another such as that taught by Levine et al. and IBM RD in order to have a first and a second pin to a user of an ATM card, each pin providing access to different parts of the transaction.

As per claim 3 & 42 Martin, Jr. et al. further discloses generating said payment service request including PINs and independent identification information (abstract, p.4, 12, 57 and 79).

As per claim 4 & 43 Martin, Jr. et al. further discloses authorizing payment to a payee (abstract; p.4, 8-9, 12-13, 57 & 79).

As per claims 5, 6, 44, 45, 67, 80 & 81 Martin, Jr. et al. further discloses wherein said payment service request further includes an amount (abstract; p.4,12,57 & 79).

As per claim 7, 46, 66 & 82 Martin, Jr. et al. further discloses wherein said independent identification information comprises an electronic personal identification number (abstract; p.4,12,57 & 79).

Art Unit: 3621

As per claims 8, 9, 47, 48, 83 & 84 Martin, Jr. et al. further discloses wherein said validating step includes:

providing an independent identification information offset (abstract; p.4,12,57 & 79);

providing a transaction identifier representing an account number (p.11 & 33); wherein said transaction identifier does not represent said user's account number (abstract; p.4, 11-12, 33, 57 & 79);

combining said user identification information and said offset to validate said user; and associating said user identification information and said offset with said transaction identifier to validate a user (abstract; p.4, 11-12, 33, 57 & 79).

As per claim 10, 49 & 85 Martin, Jr. et al. discloses a validating step as described above. Martin, Jr. et al. further discloses a message (p5, 61) transferred on an ATM compatible network, which required a pin (Abstract; p.4,5,12,57, & 79). Martin, Jr. et al. does not discloses wherein based at least in part on said validating step said ATM network transaction message includes a valid ATM network compatible PIN. Levine et al. discloses an ATM network transaction message including a valid ATM network compatible PIN (transmitting a pin; col.6, 11-24). It would have been obvious to modify Martin, Jr. et al. to include a message including a valid ATM network compatible PIN such as that taught by Levine et a. such that the pin can be transferred for security purposes as to checking the pin for accuracy and ownership to securely transmit the pin.



Art Unit: 3621

As per claim 11, 50 & 86 Martin, Jr. et al. further discloses said ATM network transaction message (p.5, 61). Martin Jr. et al. does not disclose an invalid ATM network compatible PIN. Levine discloses an invalid ATM network compatible PIN (col. 6, 11-24; col.7, 1-9 & 39-55). It would have been obvious to modify Martin et al. to include an invalid ATM network compatible PIN such as that taught by Levine et al. in order for the system to be able to distinguish an invalid pin from a valid pin and notify the user.

As per claim 12, 51 & 79 & 87 Martin, Jr. et al. further disclose wherein said payment service request further includes a payee (p8, 9 & 13).

As per claim 13, 14, 52, 53, 88 & 89 Martin, Jr. et al. further disclose including inputting said independent identification information at a network access device (abstract).

As per claim 15, 54 & 90 Martin, Jr. et al. further disclose wherein said electronic personal identification number (account number) comprises a number other than a user's ATM network compatible PIN (p33 & 11).

As per claim 62, Martin, Jr. et al. further disclose a primary account number associated with said user's bank account (p11, 33).

As per claim 63, Martin, Jr. et al. further disclose a bank identification number (routing number, p11, tables 1&2).

As per claim 64, Martin, Jr. et al. further disclose wherein said generated payment service request is stored by a merchant for forwarding to a financial institution at a selected time (abstract).

As per claim 65, Martin, Jr. et al. further disclose wherein said forwarded payment service request is forwarded to said financial institution a plurality of times (abstract).

As per claim 68, Martin, Jr. et al. further disclose wherein the step of forwarding said payment service request to said user's financial institution over an ATM network for further processing further includes authorizing payment to a payee (abstract; p.8,9,13).

As per claim 69, Martin, Jr. et al. further discloses wherein a merchant provides said independent identification information and data received by a user to a processor for validating said independent identification information and generating said payment service request (abstract; p4). Martin, Jr. et al. does not disclose a first ATM network compatible PIN and a second ATM network compatible PIN. IBM RD discloses a first ATM network compatible PIN and a second ATM network compatible PIN. It would have been obvious to modify Martin, Jr. et al. to include a first ATM network compatible PIN and a second ATM network compatible PIN such as that taught by IBM RD in order to have a first and a second pin to a user of an ATM card, each pin providing access to different parts of the transaction.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Behrang Badii whose telephone number is 571-272-6879. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Any response to this action should be mailed to:**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Art Unit: 3621

**or faxed to (571)273-8300**

Hand delivered responses should be brought to

United States Patent and Trademark Office  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Any inquiry of a general nature or relating to the status of this application  
or proceeding should be directed to the Technology Center 3600 Customer Service  
Office whose telephone number is **(571) 272-3600**.

Behrang Badii  
Patent Examiner  
Art Unit 3621

BB

*Behrang Badii*  
**PRIMARY EXAMINER**